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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Raymond King

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11/29/2006

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EXAMINER

SALL, EL HADJI MALICK

ART UNIT

PAPER NUMBER

2157

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,497	Applicant(s) KING ET AL.	
	Examiner El Hadji M. Sall	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-126 is/are pending in the application.
 4a) Of the above claim(s) 1-32 and 34-87 and 126 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 33 and 88-125 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed on October 25, 2002. Claims 1-32 and 34-87 are cancelled or withdrawn. Claims 33 and 88-126 are pending. Claims 33, 88, 89, 99, 101 and 125 are amended. Claims 1-126 represent domain name acquisition and management system and method.

2. ***Claim Rejections - 35 USC § 102***

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 33 and 90 and 95-103, 107-110 and 117-125 are rejected under 35 U.S.C. 102(e) as being unpatentable over Schneider U.S. 6,895,430.

Schneider teaches the invention as claimed including method and apparatus for integrating resolution services, registration services, and search services (abstract).

As to claims 33 and 124, Schneider teaches a method and a system for domain name management comprising:

Identifying a domain name with a first registration (column 24, line 22);

Identifying an interested party desiring a succeeding registration for the domain name (column 24, line 23-24);

Monitoring a status of the first registration (column 24, lines 45-46; figure 9b);
and

Immediately and automatically effecting the succeeding registration to the interested party when the status of the first registration indicates that the domain name is registrable, without further action by the interested party (column 7, lines 26-45; column 24, lines 40-44; figure 9b).

As to claim 90, Schneider teaches a method according to claim 89, wherein said checking includes checking the status at a predetermined frequency during the time period (column 20, lines 10-19, Schneider discloses providing the option of checking the availability of other domain names).

As to claims 95 and 96, Schneider teaches a method according to claim 89, wherein said checking includes receiving a communication pushed from a registrar; and from a registry (column 14, lines 15-21).

As to claims 97 and 98, Schneider teaches a method according to claim 33, wherein: the interested party is a registrant of the domain name; said effecting of the succeeding registration includes requesting a renewal of the registered status of the domain name for the registrant; and registration to an escrow entity, further comprising transferring the registration from the escrow entity to the interested party (column 18, lines 27-52).

As to claims 99 and 100, Schneider teaches a method according to claim 33, wherein said effecting of the succeeding registration includes initiating multiple substantially contemporaneous requests to register the domain name; and wherein the substantially contemporaneous requests are sent to multiple registrars (figure 4a; column 16, lines 29-55).

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As to claims 101, 102 and 103, Schneider teaches a method according to claims 33, 101 and 102 respectively, wherein the first registration is maintained by a registry, and further comprising: monitoring a request between a registrar and the registry to detect an event affecting the first registration; identifying the event as being of a specific type, based on the specific type of event, taking a predefined action, wherein the specific type of event is a change to a WHOIS record for the first registration; and the predefined action is notifying the interested party of the change (column 7, lines 17-28, Schneider discloses the invention enables distributed WHOIS caching to minimize network connection bandwidth. The present invention enables the real-time display of registrant information that corresponds to a current URI. The invention enables automatic notification of any identifiers that may soon be available in response to accessing such an identifier (i.e. inherently "monitoring a request between a registrar and the registry)).

As to claims 107, 108, 109, 110 and 121, Schneider teaches a method according to claims 33, 107 and 118, wherein the succeeding registration is to an escrow agent, and further comprising:

identifying a second interested party (column 24, lines 22-28);

 auctioning the succeeding registration between the interested party and the second interested party (column 14, 50-54).

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As to claims 117, Schneider teaches a method according to claim 33, wherein the first registration is maintained by a registry, and said effecting of the succeeding registration includes sending an add command to the registry (column 14, lines 15-21; column 18, lines 38-41).

As to claim 118, Schneider teaches a method according to claim 33, wherein the first registration is maintained by a registry and sponsored by a registry and sponsored by a registrar, and further comprising: prior to a purge of the first registration from the registry, re-allocating the domain name to select entity, whereby the domain name is not deleted by the registry (column 14, lines 15-21; column 18, lines 38-41).

As to claim 119, Schneider teaches a method according to claim 118, wherein the selected entity is the interested entity (column 24, line 23-24).

As to claim 120, Schneider teaches a method according to claim 118, wherein the selected entity is an escrow party (column 18, lines 46-48).

As to claim 122, Schneider teaches a method according to claim 121 wherein said auctioning is conducted prior to the first registration entering a "pending delete" status (column 18, lines 53-63).

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As to claim 123, Schneider teaches a method according to claim 33, wherein said identifying comprises receiving a back order request for the domain name from the interested party (column 24, lines 22-28)

As to claim 125, Schneider teaches a system according to claim 124, wherein:

The domain name is sponsored by a registrar having access to a registry that maintains the first registration (column 14, lines 15-21);

Said means for identifying the domain name includes an input means for receiving an indication of the domain name (column 7, lines 32-36); and

said means for monitoring the status of the first registration includes an acquisition array coupled to the input means and integrated with the registrar so as to enable the acquisition array to determine the status of the first registration and to immediately effect registration of the domain name when the status indicates that the domain name when the status indicates the domain name is registrable (column 7, lines 26-45; column 24, lines 40-44)

4. *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a

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whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 92, 93 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider U.S. 6,895,430 in view of Green et al. U.S. 6,868,441.

Schneider teaches the invention substantially as claimed including method and apparatus for integrating resolution services, registration services, and search services (abstract).

As to claims 92, 93 and 94, Schneider teaches a method according to claim 89.

Schneider fails to teach explicitly said checking includes pinging a registrar; a substantially contemporaneous pinging of multiple registrars; and pinging a registry.

However, Green teaches said checking includes pinging a registrar; a substantially contemporaneous pinging of multiple registrars; and pinging a registry (column 51, lines 50-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Schneider in view of Green to provide said checking includes pinging a registrar; a substantially contemporaneous pinging of multiple registrars; and pinging a registry. One would be motivated to do so to locate the position of the registrar (column 51, lines 52-54).

6. Claims 88, 89, 91, 104, 105, 106 and 111-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider U.S. 6,895,430 in view of Hollenbeck et al. U.S. 2005/0102354.

Schneider teaches the invention substantially as claimed including method and apparatus for integrating resolution services, registration services, and search services (abstract).

As to claims 104 and 105, Schneider teaches a method according to claim 102.

Schneider fails to teach explicitly the specific type of event is an RRP event, an RRP delete request, and the predefined action includes notifying the interested party of the RRP event and the requesting a next registration to succeed the first registration subject to the RRP delete request.

However, Hollenbeck teaches shared registration system for registering domain names. Hollenbeck teaches the specific type of event is an RRP event, an RRP delete request, and the predefined action includes notifying the interested party of the RRP event and the requesting a next registration to succeed the first registration subject to the RRP delete request (page 12, [0111]; page 13, [0136]; page 3, [0026] and [0042]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Schneider in view of Hollenbeck to provide the specific type of event is an RRP event, an RRP delete request, and the predefined action includes

notifying the interested party of the RRP event and the requesting a next registration to succeed the first registration subject to the RRP delete request. One would be motivated to do so to allow the registry to determine whether the registrar is authorized to perform an action (abstract).

As to claim 106, Schneider teaches a method according to claim 105, wherein the next registration is for the interested party (column 24, lines 22-28).

As to claims 88, 89, 91, 111, 112, 113, 114 and 115, Schneider teaches a method according to claims 33, 88, 90 and 111, wherein the first registration is maintained by a registry (figure 1f, item 178);

Periodically checking the status within the time period (figure 9b); and

Increasing the frequency of said checking, proximate to the predicted earliest moment of registrability (column 20, lines 33-40).

Schneider fails to teach explicitly further determining a deletion time period during which the first registration is expected to delete from the registry; and during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name succeed the first registration.

However, Hollenbeck teaches determining a deletion time period during which the first registration is expected to delete from the registry; and during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name succeed the first registration (page 3, [0042]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Schneider in view of Hollenbeck to provide determining a deletion time period during which the first registration is expected to delete from the registry; and during the deletion time period but prior to deletion from the registry, requesting a next registration of the domain name succeed the first registration. One would be motivated to do so to allow updates to domain names registered by the registrar (page 3, [0036]; page 5, [0051]).

As to claim 116, Schneider teaches a method according to claim 115, wherein said obtaining of the list includes querying a registrar database (column 12, lines 53-55; column 3, lines 48-62).

7. *Response to Arguments*

Applicant's arguments filed 08/21/06 have been fully considered but they are not persuasive.

(A) Applicant argues that there is no disclosure in Schneider of "automatically effecting the succeeding registration to the interested party per claim 33, and further there is no disclosure of, "identifying a second interested party; and auctioning the succeeding registration between the interested party and the second interested party,"

In regards to point (A), examiner respectfully disagrees.

In column 7, lines 26-45, Schneider discloses automatic notification of any identifiers that may soon be available, an identifier having a valid domain name is available for registration (i.e. succeeding registration to the interested party);

In column 24, lines 40-44, Schneider discloses storing the domain name in a watch list upon notifying the client that the domain name may soon be available (i.e. interested party is inherently monitoring the availability of the domain name availability, and would jump on it as soon as he get a chance)).

In column 24, lines 22-28, Schneider discloses domain name that are soon to be available may be distributed in advance to a user so that domain names of interest may be selected and reserved in a preordering queue (i.e. inherently more that one interested party are interested in registering the "soon to be available domain name", which implies "identifying a second interested party") on either the client or the server side.

In column 14, 50-54, Schneider discloses auctioning (i.e. it is inherent that in an "auction" there are more than party involved, therefore Schneider indeed teaches "auctioning the succeeding registration between the interested party and the second interested party") the domain name when available for sale.

(B) Applicant argues that based on an automated word search, "deletion date" does not appear anywhere in the Schneider patent.

In regards to point (B), examiner respectfully disagrees.

In column 24, lines 25-44, Schneider discloses the expiration date (i.e. it is inherent that when expiration occurs, there is "deletion", then registration, which could be either renewal or a new for the domain name of the WHOIS record is parsed and compared in step 954 to the current date. When the difference between the expiration date and current date is determined in step 958 to be less than a predetermined threshold value (e.g., 30 days), a client may be notified in step 962 that the domain name may soon be available.

(C) Applicant argues that Schneider's system does not, "predict[] an earliest moment of registrability for the domain name, it cannot possibly, "increas[e] the frequency for said checking.

In regards to point (C), examiner respectfully disagrees.

In column 24, lines 22-28, Schneider discloses Domain names that are soon to be available may be distributed in advance to a user so that domain names of interest may be selected and reserved in a preordering queue on either the client or server side. Registration information is completed and a registration form is submitted to or by a registrar when the soon to be available domain name that is selected does become available (i.e. "predicting an earliest moment of registrability for the domain name).

(D) Applicant argues that by contrast, a WHOIS response is just that – a response, not a push from a registrar. For at least these reasons, Schneider does not anticipate claim 95.

In regards to point (D), examiner respectfully disagrees.

In column 14, lines 16-21, Schneider discloses when a domain name is already registered (e.g., determined not available), registrant information may be provided to the client system. However, when the domain name is available, a registration form may be processed and submitted to a registrar and/or registry and to its partners and/or affiliates (i.e. data is being pulled from the data sources where “communication pushed is received”).

(E) Applicant argues that by contrast, a WHOIS response is just that – a response, not a push from a registrar. For at least these reasons, Schneider does not anticipate claim 95.

In regards to point (E), examiner respectfully disagrees.

In column 14, lines 16-21, Schneider discloses when a domain name is already registered (e.g., determined not available), registrant information may be provided to the client system. However, when the domain name is available, a registration form may be processed and submitted to a registrar and/or registry and to its partners and/or affiliates (i.e. data is being pulled from the data sources where “communication pushed is received”).

(F) As to claim 118, Applicant argues Schneider nowhere suggests a re-allocation of the name prior to purge.

In regards to point (F), examiner respectfully disagrees.

In column 18, lines 38-52, Schneider discloses "Watch example.com" may enable a user to add "example.com" to a watch list for notifying the user as to similar domain names registered or to notify that "example.com" is available or may soon be available for registration. "Renew example.com" enables a registrant to extend the expiry date of "example.com" (i.e. "re-allocating of the name prior to purge" to a selected entity (i.e. that can be a new entity or the existing entity (i.e. in this case the existing entity)) and provide the option of transferring from one registrar to another.

(G) As to claim 122, Applicant argues Schneider does not disclose auction of an expired domain name between the expiration date and the first registration entering a "pending delete" status

In regards to point (G), examiner respectfully disagrees.

Such limitation is already address in the above points.

(H) As to claim 125, Applicant argues Schneider does not disclose or suggest an "integrated with the registrar" process of using one or more cooperating Registrar's communication links directly into the registry to enable acquiring the domain name.

In regards to point (H), examiner respectfully disagrees.

Features such as "an "integrated with the registrar" process of using one or more cooperating Registrar's communication links directly into the registry to enable acquiring the domain name" are not in the claims.

(I) As to claim 115, Applicant argues Schneider does not disclose a list of deleting names for the registry, and certainly does not disclose a list "associated with an upcoming deletion data".

In regards to point (I), examiner respectfully disagrees.

The rejection of the above features was based on a combination of both Schneider and Hollenbeck. Examiner is referring Applicant to the above rejection.

8. Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

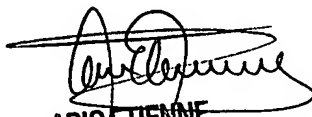
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to El Hadji M Sall whose telephone number is 571-272-4010. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

El Hadji Sall
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Art Unit: 2157


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